

## **REMARKS**

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated December 22, 2004.

Applicants respectfully request that the Examiner acknowledges the receipt of the certified priority document in next office action.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

### Status of the Claims

Claims 1-3 and 6-8 are under consideration in this application. Claims 4-5 are being cancelled without prejudice or disclaimer. Claims 1-3 and 6-7 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention. A new claim 8 is being added to recite other embodiments described in the specification.

### Additional Amendments

The Title, the claims and the drawings are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. All the amendments to the Title, the claims and the drawings are supported by the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

### Formality Rejections

The Title of the Invention was objected to as being non-descriptive and a title of "A Method and System for Persistent Translation Between Protocols" was suggested. The drawings filed on August 14, 2001 were objected to and corrections have been requested on the informalities. Claims 1 and 3 were objected to for the informalities and correction thereof has been requested. Claims 1-2 and 6-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in claiming the invention. As indicated, the Title, the drawings, and claims have been amended as required by the Examiner. Accordingly, the

withdrawal of the outstanding informality rejection is in order, and is therefore respectfully solicited.

#### Prior Art Rejection

Claims 1 and 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,434,627 to Millet (hereinafter “Millet”) in view of an article entitled “Network Address Translation – Protocol Translation” by Tsirtsis (hereinafter “Tsirtsis”), and claims 2-3 as being unpatentable over Millet and Tsirtsis and further in view of U.S. Pat. No. 5,940,478 to Vaudreuil (hereinafter “Vaudreuil”). The prior art reference of Borella et al. (6,708,219; 6,781,982; 6,697,354), Nessett et al. (6,055,236), Yanagidate et al. (6,128,664), Beser et al. (6,496,867), Jorgensen (6,590,885; 2002/0099854), Bender (6,671,735), Borella et al. (6,768,743), and Taylor (6,785,730) were cited as being pertinent to the present application. These rejections have been carefully considered, but are most respectfully traversed in view of the newly submitted claims, as more fully discussed below.

The method (as recited in claim 1) is for translating protocols at a translator 11 connected to a first network 1 for transferring data in a first protocol IPv6, to a second network 3 for transferring data in a second protocol IPv4, and to a translation server 21 to which other translators 12, 13 are connected, at least one of the other translators 12 being connected to the second network 3, a third network 2 and the translation server 21 (for example the embodiment depicted in Figs. 1-2). The method comprising the steps of: detecting an address query of a second terminal 42 accommodated in said second network 3, from a first terminal 41 accommodated in said first network 1; generating a first address in said first protocol IPv6 corresponding to a second address in said second protocol IPv4 which is provided to said second terminal 42 in the second network 3; retaining a correspondence between said first address and said second address as said translation information for a protocol translation between said first protocol IPv6 and said second protocol IPv6; and registering the correspondence between said first address and said second address at said translation server 21.

As recited in claim 2, upon receiving at said at least one of the other translators 12 a packet having said first address as a destination IP address from said first terminal 41 after a movement of said first terminal 41, the method further includes the steps of: inquiring, at said at least one of the other translators 21, of said translation server 21 about address information of said second terminal 42; receiving, at said at least one of the other translators 12, the

correspondence between said first address and said second address registered by said translator 11 from said server 21; rewriting, at said at least one of the other translators 12, said destination IP address to said second address; and transmitting, at said at least one of the other translators 12, said rewritten packet to said second terminal 42.

The invention (for example, the embodiment depicted in Figs. 1-2; pp. 13-14, 16) as recited in claim 6 is directed to an address translation server 21 connected to a first network 1 and a second network 2 for transferring data in a first protocol IPv6, and to a third network 3 for transferring data in a second protocol IPv4, and to a terminal 41 which has moved from the first network 1 to the second network 2, comprising a memory device for storing a correspondence information among a name of the terminal 41, and an address of the terminal 41 in said second protocol IPv4.

As such, even if the terminal 41 moves to another network comprising another translator 12, the other translator 12 can get the correspondence as a translation information from the translation server 21. Therefore, the terminal 41 can continue the communication with another terminal 42 even after moving while translating protocols in both cases in which the terminal is located in the home network 1 and in which it is in a foreign network 2 (P. 36, line 27 to P. 37, line 3).

Applicants respectfully submit that none of the cited prior art references teaches or suggests such “a step of registering in a translation server 21 connected to at least two translators 11, 12 the correspondence between a first address (in a first protocol) and a second address (in a second protocol) of a mobile terminal 42 in the translation server 21 (claim 1)” or such “a translation server which stores a correspondence information among a name of the mobile terminal 42, an address of the terminal 42 in the first protocol, and an address of the terminal 42 in the second protocol (claim 6)” according to the invention.

In contrast, Millet only discloses a translator, but not any translation server. Contrary to the Examiner’s assertion that the element 111 in Fig. 1B was a translator while the element 711 in Fig. 1 was a translation server (p. 6, last paragraph of the outstanding Office Action), Applicants respectfully contend that both the element 111 in Fig. 1B and the element 711 in Fig. 7 are merely translators. Since the flexible address translation system 111 is included in a foreign/remote network 105 without directly connecting any other translation systems 111 or translators (col. 5, lines 46-48), and the network address translation system 711 is merely an example of the flexible address translation system 111 (col. 12, lines 66-67). As Millet does not have any translation server, it does not register in such a translation server

correspondence between a first address in a first protocol and a second address in a second protocol of a mobile\_terminal 42.

Tsirtsis and Vaudreuil fail to compensate for Millet's deficiencies. Tsirtsis only discloses a translator (p. 4, "Protocol Translation") but not any translation server such that it does not register in such a translation server correspondence between a first address in a first protocol and a second address in a second protocol of a mobile\_terminal 42. Vaudreuil only describes network hubs 12, 14, 16 and a network center 37 that updates the information in user profile databases and message system databases comprised in the hubs (col. 4, lines 26-30; col. lines 42-50). Vaudreuil does not register in the network center 37 correspondence between a first address in a first protocol and a second address in a second protocol of a mobile terminal 42.

Applicants will further contend that the combination of references used by the Examiner merely consists of selecting bits and pieces from each reference, and then combining those bits and pieces using knowledge or hindsight gleaned from the disclosure of the present invention as a guide to support the combination. The well established rule of law is that each prior art reference must be evaluated as an entirety, and that all of the prior art must be considered as a whole," *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337, 344 (Fed. Cir. 1985). See *Para-Ordinance Mfg, Inc. v. SGS Importers Intl., Inc.*, 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995) ("Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.").

Although the invention applies the general translation mechanism as disclosed in Tsirtsis, the invention applies the mechanism on **mobile terminals** to achieve unexpected results or properties. For example, like the priori art describe on p. 2 last paragraph of the specification, Tsirtsis does not involve any mobile terminals therefore it does not provide a translation server 21 connected to at least two translators 11, 12 for registering therein the correspondence between a first address (in a first protocol) and a second address (in a second protocol) of a mobile terminal 42. The presence of these unexpected properties is evidence of nonobviousness. MPEP§716.02(a).

*"Presence of a property not possessed by the prior art is evidence of nonobviousness. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); Ex parte*

*Thumm, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing " 'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' ").*

Although “[t]he submission of evidence that a new product possesses unexpected properties does not necessarily require a conclusion that the claimed invention is nonobvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979). See the discussion of latent properties and additional advantages in MPEP § 2145”, the unexpected properties were unknown and non-inherent functions in view of Tsirtsis, since Tsirtsis does not inherently achieve the same results. In other words, these advantages would not flow naturally from following the teachings of Tsirtsis, since Tsirtsis fails to suggest providing a translation server 21 connected to at least two translators 11, 12 for registering therein the correspondence between a first address (in a first protocol) and a second address (in a second protocol) of a mobile terminal 42 as the invention.

Applicants further contend that the mere fact that one of skill in the art could rearrange the cited prior art references to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for one skilled in the art to provide the unexpected properties, such as enabling a communication to be continued without any interruption even if one or both of terminals move if a protocol translation is necessary at a junction of both networks due to a difference between protocols of these network accommodating one and the other terminals (p.4, lines 2-13), without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). MPEP§2144.04 VI C.

Applicants contend that Millet, Tsirtsis and Vaudreuil and their combinations fail to teach or disclose each and every feature of the present invention as disclosed in independent claims 1 and 6. As such, the present invention as now claimed is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

### Conclusion

In view of all the above, clear and distinct differences as discussed exist between the

present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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SPF/JCM/JT

**IN THE DRAWINGS:**

Please enter the attached corrected drawings Figs. 3, 14, 27, 29, 31, 56, 62, and 63, wherein in Fig. 3 the path from element 42 through 31 to element 41 going through translator 13; in Fig. 14, the direction of the path from element 43 to element 44 via element 11 is being reversed; in Fig. 27 DNS RESPONSE (ADDR:f4) is being redirected to start from element 11 rather than element 12; in Fig. 29, “p6” in BINDING UPDATE (NEW COA=p6) is being amending into “q6”, in Fig. 31, “q6” in the box of q6-h6-t6-s6 is being amended into “p6”; in Fig. 56, the additional “.” in the heading of “Figs. 54-55” is being removed; in Fig. 62, “Fig. 59” is being added to the last line of text; in Fig. 63, the additional “.” in the heading of “Figs. 60-61” is being removed, to replace Figs. 3, 14, 27, 29, 31, 56, 62, and 63 as originally filed. A Letter to Draftsperson is also submitted herewith.